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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/113,712 07/10/98 HELINSKI E EN997043

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QM12/0508

EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

05/08/00

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/113,712

Applicant(s)
Helinski

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Feb 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) 12-20 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendment filed February 24, 2000 has been entered.

Claim Rejections - 35 USC § 101

2. Claims 6-11[✓] are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. According to applicant, particularly applicant's remarks in the paragraph bridging page 4 and 5 of the amendment filed June 15, 1999, the claimed punch and die assembly is not used to punch a workpiece in the claimed configuration and thus lacks utility.

Claim Rejections - 35 USC § 112, 1st paragraph

3. Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In general, it remains unclear as to how the punch and die assembly operates as depicted in Figure 2 wherein the upper die 25 is partially inserted into the die-receiving passage 34 of the lower housing 33. That is, it is not clear how the material is positioned between the upper die 25 and lower die 26.

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Claim Rejections - 35 USC § 112, 2nd paragraph

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 10, ✓“the second die receiving passage” lacks positive antecedent basis.

In claim 3, line 2, ✓“the first die receiving passage” lacks positive antecedent basis; in lines 3-4, “configured to permit ...” is vague and indefinite since it is not clear how this limitation further defines the invention with respect to claim 1 - i.e., how is the configuration of the second die passage defined in this claim different than the configuration defined in claim 1, and it appears that with respect to the second die passage, this limitation appears to be redundant. ←

In claim 6, line 10, ✓“the second die receiving passage” lacks positive antecedent basis.

In claim 8, line 2, “the first die receiving passage” lacks positive antecedent basis; in lines 3-4, “configured to permit ...” is vague and indefinite since it is not clear how this limitation further defines the invention with respect to claim 6 - i.e., how is the configuration of the second die passage defined in this claim different than the configuration defined in claim 6, and it appears that with respect to the second die passage, this limitation appears to be redundant. ←

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kranik et al.

Kranik et al. discloses a system with every structural limitation of the claimed invention including a first die (e.g., the die which includes surface 28) including a first aperture; a second die (e.g., 48) including a second aperture; a first housing (e.g., 14) including a first die passage; and a second housing (e.g., 42) including a second die passage; wherein the figures show the first die received in the first die passage of the first housing, and show the second die received in the second die passage of the second housing as set forth in claim 1. Regarding claims 2, 6 and 7, the first and second dies are substantially the same diameter. Thus, the first die (e.g., in the extended position shown in Figure 1) can clearly be received in the second die passage if the second die is moved downwardly within the second die passage. Such a manipulation of the disclosed components is considered an intended use of the system disclosed by Kranik et al.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kranik et al.

Regarding claims 4, 5, 8 and 9, Kranik et al. lacks alignment marks on the respective dies and lacks a specific disclosure of the alignment accuracy of the die apertures. However, the Examiner takes Official notice that it is old and well known in the art, particularly the manufacturing art, to custom manufacture cooperating components and to provide alignment marks on the components to facilitate the desired alignment of the components. Therefore, it would have been obvious to one having ordinary skill in the art to provide alignment marks on the dies of Kranik et al., and to provide an accurate alignment of the die apertures for the well known benefits including that described above.

Regarding claim 11, Kranik et al. discloses a compression spring, but lacks the particular relationship between the spring, the punch and the housings. However, the Examiner takes Official notice that it is old and well known in the art to provide compression springs in any one of various known configurations to provide a biasing force to a punch. Therefore, it would have been obvious to one having ordinary skill in the art to provide the particular relationship between

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the spring, the punch and the housings as an alternative configuration for biasing the punch based on known considerations such as manufacturing considerations.

Response to Arguments

9. Applicant's arguments filed June 15, 1999 have been fully considered but they are not persuasive.

On pages 4 and 5 of the amendment, applicant argues that the invention claimed in claim 1 is drawn to a punch and die alignment system, and thus the claimed invention has utility. The Examiner respectfully submits that while this argument is persuasive for claims 1-5, it is not persuasive for claims 6-11 which set forth a punch and die assembly since the punch and die assembly in such a configuration would have no utility. The Examiner respectfully takes the same position with respect to the rejection of claims 6-11 under 35 USC 112, first paragraph.

On pages 6-8 of the amendment, applicant argues that the prior art does not disclose a system for aligning dies in a punch and die assembly. However, it is respectfully submitted that it is not the Examiner's position that the prior art performs the same function as the present invention (i.e., providing alignment). Rather, it is the Examiner's position that the prior art teaches or suggests all of the claimed structure.

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Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', is positioned above the printed name.

Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
May 8, 2000